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10/057,016	01/25/2002	Theodore Turnasella	54530-00002	3598
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Daniel P Burke Galano & Burke LLP 300 Rabro Drive Suite 135 Hauppauge, NY 11788			EXAMINER CHEN, TE Y	
			ART UNIT 2161	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/057,016

Applicant(s)

TURNASELLA, THEODORE

Examiner

SUSAN Y. CHEN

Art Unit

2161

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 32-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 32-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Oct. 27, 2008 has been entered.

This office action is in response to the amendment filed on Oct. 27, 2008.

Claims 1-30, 32-42 are pending for examination, claims 1, 2, 7, 12, 20, 21, and 30 have been amended; claims 39-42 have been newly added and claim 31 has been canceled.

Claim Objections

Claims 1-30 and 32 -42 are objected to because of the following informalities:

As to claims 1, 12 and 20, the claimed "a server" could be broadly interpreted as "a software server", in such case, these claims might subject to 35 U.S.C. 101 rejections. In re Bilski. No. 07-1130 (Fed. Cir. Oct. 30, 2008) (en banc).

Art Unit: 2161

As to claims 2-11, 13-30 and 32-42, these claims failed to resolve the defects as their base claims, hence, are objected for the same reason.

As to claims 35 -37, these claims depend on claim 27, which is a system claim and not a method claim, as such, the phrase "method" of these claims should be changed to "system".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19, 32-33 and 38-42 , are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, this claim repeatedly use the open-ended phrases "comprising", "include" and "at least one of" that make it hard to determine what are the claimed "parameters for inclusion in said self-designated group and job positions" as well as "a plurality of parameters utilizing standard query language". As such, it renders the claim written in Markush format.

As to claim 12, what does the claimed "the type of participants" refer to (i.e., does it refer to the "account code type" in section 0043, or "the type of membership" at section 0052 or "the type of network by members" at section 0057, or others?)

As to claims 2-11, 13-19, 32-33 and 38-42, these claims have the same defects as their base claims, hence, are rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 and 32-42, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,741,993 issued to Zitaner et al. (hereinafter referred as '993) in view of U.S. Patent No. 6,401,079 issued to Kahn et al. (hereinafter referred as '079) and further in view of U.S. Patent No. 6,249,770 issued to Erwin et al. (hereinafter referred as '770).

Art Unit: 2161

As to claims 1, 12 and 20, the '993 patent discloses a system for providing survey data from members of a survey group via an Internet [e.g., Abstract, Fig. (s) 1-4], comprising:

a) a database for storing salary data [e.g., the unit 10, Fig. 1];

b) a server [e.g., the Reward Workbench (60), Fig. 1] providing access to the Internet, wherein the server configured to:

establishing a salary survey service on a server [e.g., the Reward Workbench (60) manages salary survey services over the Internet, Fig(s). 1-2 and associated texts] for storing and accessing salary data via a database [e.g., the use of units 10, 50, etc Fig. 1 and associated texts], said service establishing step comprising establishing, for a self designated group, parameters for inclusion in said self-designated group and job positions to include in the salary survey [e.g., The rewards workbench can optionally be operable to automate data feeds to at least one third party human resources management system at the "Summary". In addition, Rewards workbench 60 provides members with a comprehensive analytic tool operable to access data contained in the competitive rewards database subsystem. The rewards workbench is preferably operable to: query prevalence of reward practices and plan provisions, compare member reward values to specific comparator groups, develop market reference data from the competitive rewards database, model and develop base pay structure, analyze cost implications, conduct data mining analyses on member's own data, and generate other custom real-time analyses on the competitive rewards database at col. 6, lines 23 -36];

receiving, verifying and storing salary data received from a plurality of member companies in a database associated with the server [e.g., Competitive rewards data can be compiled in-house or can be obtained from a variety of sources (out-sourced). A typical competitive rewards database contains: base salary information, incentives and total cash compensation as well as other factors such as use of overtime, stock plans and cash awards (like performance bonuses and profit sharing). Reports generated from such data can contain global or national salary information as well as breakouts based on numerous criteria, including sales revenue, geographic region, industry type, company size and the like at col. 1, lines 26 - 35. Figs(s) 3-4 and associated texts]

entering a plurality of parameters utilizing standard query language, said parameters comprising at least one of job position [e.g., Typical network processing devices include, but are not limited to, personal computers (portable or desktop), personal digital assistants (PDA), Browser phones, 2-way pagers or the like. Network processing devices also include browser software or the like for providing a user interface and enabling communication with the external data network. In addition, as stated above some of the raw data may be translated, scaled, re-formatted, re-calculated and/or adjusted as necessary for compatibility with the format of the competitive rewards database. For example, some HRMS may specify a given employee position by a text string (e.g., ASCII code). The competitive rewards database may be advantageously implemented with a plurality of numeric codes (i.e., job codes). Translation of text strings to numeric codes as well as general implementation of a data mapping table in accordance

Art Unit: 2161

with the invention based on the foregoing disclosure is well within the scope of those skilled in the art];

generating a salary report for the survey group and for said entered parameters [e.g., Reports generated from such data can contain global or national salary information as well as breakouts based on numerous criteria, including sales revenue, geographic region, industry type, company size and the like at col. 1, lines 32 – 35, A data capture tool 50 is coupled to the competitive rewards database subsystem. The data capture tool is preferably an Internet World Wide Web based "smart" tool to capture HR and Line Manager input on benchmark global job matches. Preferably, the data capture tool is populated with appropriate employee data (based on data in the competitive rewards database) according to reporting relationships. Line Managers can then advantageously review data for each employee they supervise at col. 4, lines 19 - 27].

The '993 patent did not specifically disclose aging at least a portion of said salary data at the time of generating said report for at least a portion of stored salary data and generating a salary report for participants of the survey group using the aged salary data.

However, the '079 patent disclosed the claimed features of aging at least a portion of said salary data at the time of generating said report for at least a portion of stored salary data and generating a salary report for participants of the survey group using the aged salary data. [e.g., the use of effective date, expiration date attributes of the Pay Scales table 435, the Pay Rate Types (430)

to calculate and report a portion of an employee salary cost disbursement, etc. Fig(s). 3, 4(a) (b), 10(a) -10(c), 12(a)-12(c), 14(a)-14(e) and associated texts].

The '993 and '079 patents are both in the same endeavor for efficiently reporting survey salary information via graphical interactive user interface [e.g., the Web unit 50, Fig. 2 of '993, the Fig(s). 18a - 18c of '079], thus, with the teachings of '993 and '079 in front of him/her, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to be motivated to modify the salary information of '993 system with aging attributes as taught by '079 patent, because by doing so, the combined system will be upgraded to provide more details information for the pay scale survey and calculation.

The combination of '993 and '079 did not specifically disclose utilizing at least one annual growth rate entered at the time of generating said report.

However, '770 patent disclosed the step to utilize at least one annual growth rate entered at the time of generating said report [e.g., col. 11, line 48 – col. 12, line 20, Fig. 23].

The combination of '993, '079 and '770 patents are in the same endeavor for efficiently reporting survey salary information [e.g., the Web unit 50, Fig. 2 of '993, the Fig(s). 18a - 18c of '079, Fig. 23 of '770], hence, with the teachings of '993, '079 and '770 in front of him/her, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to be motivated to modify the salary reporting information of the combined '993 and '079 system

Art Unit: 2161

with the annual growth rate data as taught by '079 patent, because by doing so, the combined system will be upgraded to utilizing at least one annual growth rate entered at the time of generating to forecast a more accurate aged pay scale survey report with the annual growth rate details.

As to claims 2, 13 and 21, except all the features recited in claim s 1, 12 and 20, the combined system of '993, '079 and '770 patents further discloses that the survey are group by at least one of the business organization or others [e.g., '993: col. 1, lines 14-22].

As to claims 3-6, 14-16 and 22-25, except all the features recited in claims 1, 12 and 20, the combined system of '993 '079 and '770 patents further discloses that the members including individuals, companies, trade associations, contributor and subscriber [e.g., '993: col. 1, lines 26-35].

As to claims 7-8 and 26-27, except all the features recited in claims 1, 12 and 20, the combined system of '993 '079 and '770 patents further discloses that the server is further configured to receive designations of the members to be included in the survey group and parameters to defining information to be presented by the survey [e.g., '993: the first three steps of Fig. 3; Figure 4 and associated texts, the selectable analyzing sub-group in claim 6].

As to claims 9-10, 17-18 and 28-29, except all the features recited in claims 1, 12 and 20, the combined system of '993 '079 and '770 patents further discloses that the server is configured to provide access to the plurality members of the survey group [e.g., '993: the units 30, 32, 34, 36, Fig. 1].

As to claims 11, 19 and 30, except all the features recited in claims 1, 12 and 20, the combined system of '993 '079 and '770 patents further discloses that the salary data is related to job positions [e.g., '993: the Job_code, Position fields, Fig. 4].

As to claims 32-37, the claimed limitations that said at least parameter comprising company size, industry, and geographic region are common default parameters of a salary survey service system.

As to claim 38, the combined system of '993 '079 and '770 patents further discloses the claimed steps of holding received data for verification and releasing salary data after verification [e.g., '079: Abstract, lines 19 – 29].

As to claims 39—42, except all the features recited in claims 1, 12 and 20, the combined system of '993 '079 and '770 patents further discloses that the steps of receiving, verifying and storing salary data comprising initially locating received data in an unconfirmed database table, verifying data from said unconfirmed database table, transferring verified data to a wage information

Art Unit: 2161

database table and archive the verified data [e.g., Abstract, In operation, each of the member computer systems transmits raw data to the competitive rewards database system. The raw data is mapped and re-formatted as necessary and is incorporated into the competitive rewards database. Data capture tool 50 can then be used by members (e.g., HR Managers, Line Managers) to view portions of the competitive rewards database populated with appropriate employee data according to reporting relationships. The Manager can then review data for each employee they supervise. Preferably, menu-driven options are provided thereby enabling the Manager to "tag" employees--by function, discipline, level, and scope--and flag high-performers. Preferably, on-line help is available to guide managers through the matching process. In a preferred aspect of the invention, HR and Line Managers can review and update the mapping and competitive rewards database information as part of on-going HR processes at col. 6, lines 1 - 17, Fig(s) 3-4 and associated texts].

Response to Arguments

Applicant's arguments filed on March 03, 2008 have been fully considered but they are not persuasive.

Applicant's mainly argued that "Zitaner does not teach or suggest a self designated survey group, or the step of establishing parameters for inclusion in a self designated group and the job positions to include in the salary survey for the self designated survey group".

In reply to the above arguments, the examiner directs applicant's attention to the excerpts of Zitaner:

For example, Zitaner clearly disclosed that "The rewards workbench can optionally be operable to automate data feeds to at least one third party human resources management system" at the "Summary". In addition, he further disclosed that "Rewards workbench 60 provides members with a comprehensive analytic tool operable to access data contained in the competitive rewards database subsystem. The rewards workbench is preferably operable to: query prevalence of reward practices and plan provisions, compare member reward values to specific comparator groups, develop market reference data from the competitive rewards database, model and develop base pay structure, analyze cost implications, conduct data mining analyses on member's own data, and generate other custom real-time analyses on the competitive rewards database" at col. 6, lines 23 -36.

Moreover, Zitaner clearly disclosed the claimed storing, verification, transferring data from an unconfirmed table to a wage information table after the data has been verified at Abstract, col. 6, lines 1 - 17, Fig(s) 3-4 and associated texts.

Thus, as set forth above, in contrary to applicant's arguments, Zitaner clearly anticipates the claimed limitations.

Because applicant does not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections/rejections made. Further, they do not show

Art Unit: 2161

how the amendments avoid such references or objections/rejections. The examiner concludes that the prior art on record read on the claimed features.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN Y. CHEN whose telephone number is (571)272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2161

/Susan Y Chen/
Partial Sig. Examiner
Art Unit 2161

November 10, 2008

Application Number**Application/Control No.**

10/057,016

**Applicant(s)/Patent under
Reexamination**

TURNASELLA, THEODORE

Examiner

SUSAN Y. CHEN

Art Unit

2161